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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/554,914

10/31/2005

Akinori Kurimoto

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07/25/2006

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EXAMINER

MAYO III, WILLIAM H

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/554,914

Applicant(s)

KURIMOTO ET AL.

Examiner

William H. Mayo III

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/05/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in PCT National Stage Application No. PCT/JP04/06051, filed on April 27, 2004.

### ***Information Disclosure Statement***

2. The information disclosure statement filed October 31, 2005 has been submitted for consideration by the Office. It has been placed in the application file and the information referred to therein has been considered.

### ***Drawings***

3. Figures 11a-11b should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

5. The abstract of the disclosure is objected to because in lines 7-10, the abstract refers to purported merits, which is improper content for the abstract. The applicant should delete the terms "errorlessly" and "without consulting a manual or the like".

Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Saito et al (JP Pat Num 11-297129, herein referred to as Saito). Saito discloses a cable (Figs 1-3) comprising a wire, wherein the terminals of the wire can be identified with the collation of the cable identifying codes (abstract). Specifically, with respect to claim 1, Saito discloses a cable (1, Fig 1) comprising a wire (2) having an indicating member (4 & 5) provided on the covering sheath (not numbered) of the wire (2), wherein the indicating member (4 & 5) indicates an operation region (termination of connector) and includes a first marking (5) and a second marking (4), which are provided at a predetermined interval along the longitudinal direction of the covering sheath (not numbered) of the wire (2), wherein the first marking (5) indicates an operation position (termination of connector) and the second marking (4) indicates an operation form (type and function of the wire, paragraph 6 under heading Detailed Description). With respect to claim 2, Saito discloses that the first marking (5) indicates the operation position arranged between the first marking (5) and the second marking (4, i.e. marks 4 & 5 are alternatively placed on the cable along a length of the cable therefore a second marking (4) existed on the left side of mark (5) shown in Figure 1 prior to terminated the connector (3) on the cable thereby having the termination location between the first and second markings (4 & 5). With respect to claim 3, Saito discloses that the first marking (5) indicates a operation position (i.e. termination located adjacent the mark (5) to which a branch wire (not shown) is to be connected via another connector (not shown, paragraph 5) and the second marking (4) indicates the number of the branch wire (not

shown) and installation location of the branch wire (not shown, i.e. 4 denotes the type and function of the wire such as ABS or airbag in auto and thereby the operator would know how many wires and where to attach them). With respect to claim 4, Saito discloses that the first marking (5) indicates a operation position (i.e. termination located adjacent the mark (5) to which a branch wire (not shown) is to be connected via another connector (not shown, paragraph 5) and the second marking (4) indicates the number of the branch wire (not shown) and installation location of the branch wire (not shown, i.e. 4 denotes the type and function of the wire such as ABS or airbag in auto and thereby the operator would know how many wires and where to attach them).

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito (JP Pat Num 11-297129) in view of Unterberger (Pat Num 5,645,899). Saito discloses a cable (Figs 1-3) comprising a wire, wherein the terminals of the wire can be identified with the collation of the cable identifying codes (abstract) as disclosed above with respect to claims 1-3.

However, Saito doesn't specifically disclose at least one of the first and second marking being formed of heat sensitive paint (claims 5-7).

Unterberger teaches a method and apparatus (Figs 1-4) comprising forming first and second markings on an elongated cable, thereby providing the cable with color identifiers that are simple to attach and is done so with optimum efficiency (Col 1, lines 35-38). Specifically, with respect to claims 5-7, Unterberger teaches a cable (AD, Fig 2), wherein the cable sheath (AD\*) comprises a first marking (FP1) and a second marking (ST1), wherein the first and second marking (FP1 & ST1, respectively) are heat sensitive paint (Cols 3 & 4, lines 1-6 & 9-14).

With respect to claims 5-7, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the insulated wire of Saito to comprise the first and second markings to comprise heat sensitive paint as taught by Unterberger because Unterberger teaches that such a configuration provides the cable with color identifiers that are simple to attach and is done so with optimum efficiency (Col 1, lines 35-38).

11. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Own Admission of Prior Art (Figs 11a-11b, herein referred to as AOAPA) in view of Saito (JP Pat Num 11-297129). AOAPA discloses a known wire connecting method (Pages 1-2 of Specification, Figs 11a-11b) of connecting a second wire serving as a branch wire (100) to a predetermined position of the first wire serving as a main wire (101). Specifically, with respect to claim 8, Saito discloses a known wire connecting method (Pages 1-2 of Specification, Figs 11a-11b) of connecting a second wire serving as a branch wire (100) to a predetermined position of the first wire serving as a main wire (101), wherein the method comprises beforehand providing a first marking (slit 102) at a predetermined interval (103) along a longitudinal direction of the covering sheath (101a) of the first wire (101, Page 1, lines 10-17), connecting the second wire (100) in accordance with a connecting position (103) indicated by the first marking (102) and installing a second wire (100) to connect with the main wire (101, Pages 1-2, lines 18-25 & 1-4, respectively). With respect to claim 9, Saito discloses a known wire connecting method (Pages 1-2 of Specification, Figs 11a-11b) of connecting a second wire serving as a branch wire (100) to a predetermined position of the first wire serving as a main wire (101), wherein the method comprises beforehand providing a first marking (slit 102) at a predetermined interval (103) along a longitudinal direction of the covering sheath (101a) of the first wire (101, Page 1, lines 10-17), connecting the second wire (100) in accordance with a connecting position (103) indicated by the first marking (102) and installing a second wire (100) to connect with the main wire (101, Pages 1-2, lines 18-25 & 1-4, respectively).



However, AOAPA doesn't specifically disclose the method of providing a second mark at a predetermined interval, wherein the second wire is connecting in accordance with the connection form indicated by the second marking (claims 8-9).

Saito teaches a cable (Figs 1-3) comprising a wire, wherein the terminals of the wire can be identified with the collation of the cable identifying codes (abstract). Specifically, with respect to claims 8-9, Saito teaches a cable (1, Fig 1) comprising a wire (2) having an indicating member (4 & 5) provided on the covering sheath (not numbered) of the wire (2), wherein the indicating member (4 & 5) indicates an operation region (termination of connector) and includes a first marking (5) and a second marking (4), which are provided at a predetermined interval along the longitudinal direction of the covering sheath (not numbered) of the wire (2), and the second marking (4) indicates an operation form (type and function of the wire, paragraph 6 under heading Detailed Description) and installation location of the branch wire (not shown, i.e. 4 denotes the type and function of the wire such as ABS or airbag in auto and thereby the operator would know how many wires and where to attach them).

With respect to claims 8-9, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the insulated wire of AOAPA to comprise the first and second marking configuration as taught by Saito because Saito teaches that such a configuration provides a wire, wherein the terminals of the wire can be identified with the collation of the cable identifying codes (abstract).

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They are Kondo (JP Pat Num 10-031918), Yahagawa et al (JP Pat Num 2003-168329), Baker (Pat Num 3,197,554), Andrews et al (Pat Num 4,997,994), Kihlken et al (Pat Num 5,142,105), Bryce (Pat Num 4,607,432), Kamata et al (Pat Num 2006/0021785), Clinton (Pat Num 4,387,665), and Ryeczek (Pat Num 6,388,194), all of which disclose cables having markings.

### ***Communication***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William H. Mayo III  
Primary Examiner  
Art Unit 2831

WHM III  
July 20, 2006